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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Jean-Philippe Pascal

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04/22/2008

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.

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ALEXANDRIA, VA 22314

EXAMINER

DEES, NIKKI H

ART UNIT

PAPER NUMBER

1794

NOTIFICATION DATE

DELIVERY MODE

04/22/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/539,570	Applicant(s) PASCAL ET AL.	
	Examiner Nikki H. Dees	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>13 November 2007, 19 February 2008</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Amendment filed on February 19, 2008, has been entered. Claims 11-23 remain pending in the application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claim 21 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. It is unclear what level of acarids must be present to constitute an "infestation."

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1794

6. Original claims 11-20 and amended claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misato et al. (4,599,233) in view of Applying Pesticides Correctly (The Ohio State University, 1992) and Knight (5,439,690).

7. Misato et al. teach a fungicide composition comprising sodium bicarbonate (Abstract). They state that their composition may contain 10-100 percent of the effective components (col. 5 lines 42-43). They go on to state that their composition may also contain a carrier such as silica (col. 5 line 20). This reads on Applicants' claims 11, 15, and 18.

8. Misato et al. disclose that their composition may be sprayed onto plant material (col. 8 lines 18-20), as well as fruits and vegetables (col. 3 lines 20-21). They state that their composition will not have adverse effects if it were to be consumed by humans (col. 3 lines 23-25). This renders Applicants' claim 16 obvious. By being safe for human consumption, it is inherent that this composition not contain neurotoxic substances.

9. Misato et al. are silent as to the use of their composition as an acaricide. However, patentability is dependent on the composition, not the intended use. The composition taught by Misato et al. as a fungicide would also function as Applicants' claimed composition as a fungicide, acaricide and insecticide given that the active ingredient in both compositions is the same. This reads on Applicants' claims 17 and 20.

Art Unit: 1794

10. Misato et al. are silent as to cereals being treated with their composition, and to their composition being sprayed on silo walls. They are also silent as to the particle size of the powder in their composition, and the specific use of silica gel.

11. Regarding claim 12, Applying Pesticides Correctly teaches that a wettable powder formulation of a pesticide will leave more pesticide on the surface (p. 72 col. 2). They go on to state that spaces such as silos may be treated (p. 72 col. 2). Additionally, they speak to the covering of surfaces with pesticides (p. 73 col. 2).

12. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have sprayed the composition taught by Misato et al. onto surfaces as taught in Applying Pesticides Correctly in order to coat the inside surface of a silo so that the pesticide may come into contact with cereals stored in the silo.

13. Regarding claims 13 and 14, Knight teaches a non-toxic pesticide comprising an alkali metal bicarbonate (col. 1 lines 5-10, 65-66). One embodiment comprises sodium bicarbonate (col. 3 lines 67-67). Particle size for the invention is preferably under 100 microns (col. 3 lines 57-58).

14. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the particle size taught by Knight in the composition taught by Misato et al. in order to produce a composition with a particle size best suited for coating the intended target.

15. Regarding combating acarids in the storage of cereals, as the composition taught by Misato et al. is used on fruits and vegetables, it would have been obvious to one of

Art Unit: 1794

ordinary skill in the art to extend the application of the fungicide/insecticide/acaricide to cereals as well.

16. In regard to claim 19 and the use of silica gel in particular, it would have been obvious to one of ordinary skill in the art to have selected silica gel for use in the invention of Misato et al. as it is widely known and readily available desiccant. One skilled in the art would also have been able to adjust the amount of silica gel used in the invention to result in a product with the most desirable properties for the intended application.

17. Regarding claims 21 and 23, it would have been obvious to one of ordinary skill in the art to extend the application of the fungicide/insecticide/acaricide to cereals as well as explained above. Fungicides/insecticides/acaricides are known to be applied when pests are present, and also as a preventative measure. Whether the cereals are contacted with the composition before acarids are present or the acarids are contacted with the composition

18. Regarding claim 22, Misato et al. teach that their composition may comprise up to 100 percent of the active ingredient sodium bicarbonate. This teaching renders applicant's claim of combating acarids with a composition consisting essentially of sodium bicarbonate obvious over the prior art.

Response to Arguments

19. Applicant's arguments filed February 19, 2008, have been fully considered but they are not persuasive.

20. Applicant argues (Remarks, p. 1) that the discovery of a new use for an old composition based on an unknown property of the composition **is** patentable as a process and cites the relevant case law and section of the MPEP (emphasis added).

21. The MPEP in the examiner's possession states that "the discovery of a new use for an old structure based on unknown properties of the structure **might be** patentable to the discoverer as a process of using. *In re Hack*, 114 USPQ 161, 163 (CCPA 1957). The MPEP continues "However, when the claim recites using an old composition or structure and the "use" is directed to a result or property of that composition or structure, then the claim is anticipated. See *In re May* 197 USPQ 601, 607 (CCPA 1978) and MPEP 2112.02.

22. In the instant case, the use of sodium bicarbonate is recognized in the prior art as an insecticide. The discovery that sodium bicarbonate also functions as an acaricide does not render the new use unobvious over the prior art as the use is directed to a property of the known compound sodium bicarbonate.

23. Applicant argues (Remarks, p. 2) that neither Misato nor "Applying Pesticide Correctly" teaches that sodium bicarbonate should be used in cereals.

24. Regarding Applicant's argument that neither Misato nor "Applying Pesticides Correctly" teaches that sodium bicarbonate should be used in cereals, Misato teaches

Art Unit: 1794

that their product is safe for use on plants and fruits and vegetables. One of ordinary skill, wishing to employ a fungicide that was safe for human consumption on cereal crops, would recognize that sodium bicarbonate would be a preferable choice due to the fact that it is non-toxic.

25. Applicant argues (Remarks, p. 2) that Knight is treating insects, not acarids, and that the mechanism of action depends on the insecticide entering the insect bodies between the exoskeleton plates.

26. In regard to this argument, the examiner would like to draw Applicant's attention to Knight col. 2 lines 56-63 wherein Knight states that the crystalline particles of the invention ... tend to pierce the exoskeleton. One of ordinary skill would expect the piercing of the exoskeleton to occur regardless of whether or not the exoskeleton was in one piece, as for an acarid, or more than one piece, as for an insect.

Conclusion

27. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

Art Unit: 1794

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikki H. Dees whose telephone number is (571) 270-3435. The examiner can normally be reached on Monday-Friday 7:30-5:00 EST (first Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1794

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nikki H. Dees
Examiner
Art Unit 17944174

/Carol Chaney/
Supervisory Patent Examiner, Art Unit 1794